UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MCHAEL S. BENDER and ALOYSIUS C. ASHLEY
WIJEYERATNAM

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Appeal 2009-002618
Application 10/780,270[1]
Technology Center 2100

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Decided: March 8, 2010

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
JAY P. LUCAS, *Administrative Patent Judges.*

HOMERE, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

_____

[1] Filed on February 17, 2004. The real party in interest is Sun
Microsystems, Inc. (App. Br. 2.)

STATEMENT OF THE CASE

In a paper filed January 5, 2010, Appellants request a rehearing under 37 C.F.R. § 41.52 from the Opinion of the Board of Patent Appeals and Interferences (hereinafter Board) dated November 5, 2009. In the Opinion, we affirmed the Examiner's rejection of claims 1 through 21. Appellants allege that the Board erred by misapprehending or overlooking numerous arguments presented in the Brief. Specifically, Appellants allege that the Board erred as follows:

> (1) in finding that Billington's disclosure teaches that a user of a stateless client device may access a locally coupled mass storage device via a server. (Req. Reh'g 3.);
>
> (2) in combining distinct embodiments of Billington to sustain the Examiner's anticipation rejection of claim 1. (*Id.* at 6);
>
> (3) in finding that Billington's disclosure teaches that the user interacts with an application that the server is configured to execute. (*Id.* at 7.)

Consequently, Appellants request a rehearing of the Board's Decision affirming the rejection of independent claims 1, 8 and 15. (*Id.* at 9.)

We have carefully reviewed the Opinion in light of Appellants' remarks. We address those remarks in the order in which they are presented in the Request.

1A. Appellants argue the Board's decision fails to discuss, as raised in the Appeal and Reply Briefs, how Billington's server, the thin client, the mass storage device, and the user are interrelated to teach (1) a server configured to execute an application, (2) a stateless client configured to

enable a user to interact with the application, and (3) a mass storage device locally coupled to the stateless client and accessible by the user via the server, as recited in independent claim 1. (Req. Reh'g 5.) We do not agree.

In our original analysis, we found that Billington's disclosure teaches that the thin client possesses sufficient functionality to interact with the mass storage device to store data therein via the processor server. (Op. 10.) Further, we modify our analysis in the original Opinion as follows:

Regarding the disputed limitations of claim 1, we note that while the recited *server is configured to execute* an application, and the *stateless client is configured to* enable the user to access the application, these devices are not actually performing any of the recited functions. The claim language merely requires that these devices be capable of performing those functions. Similarly, the claim language only requires the mass storage device to be *accessible (i.e. capable of being accessed)* by the user. These recitations are therefore statements of intended use, which are fully met by an anticipating prior art structure that is capable of performing those intended uses. That is, a statement of intended use in an apparatus claim cannot distinguish over a prior art apparatus that discloses all the recited limitations and is capable of performing the recited function. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *In re Dense*, 156 F.2d 76, 76 (CCPA 1946). *See also Ex parte Satchell*, Appeal No. 2008-0071, 2008 WL 4828136, at *15 (BPAI 2008) (non-precedential).

As set forth in the Opinion, Billington discloses a mass storage device locally coupled to a thin client, which in turn communicates with a processor server. (Op. 6, FF. 1.) We find that, upon a user's request, the server is capable of executing an application selected thereon. Further, we agree with

Appellants' argument that it is conceivable from Billington's disclosure of the thin client's coupling with the mass storage device that the thin client is capable of interacting with the mass storage device without involving the server. (Req. Reh'g 5.) Likewise, we find that it is also conceivable from Billington's disclosure of the mass storage device's coupling with the thin client, which in turn communicates with the processor server, that the user of the thin client is capable of accessing the mass storage device via the server. Consequently, we find that such capabilities that emanate from Billington's disclosure reasonably bolster our initial position that the thin client possesses sufficient functionality to interact with the mass storage device to store data therein via the processor server.

1B.   Appellants further argue that the Board's analysis impermissibly combines distinct embodiments to find anticipation. (Req. Reh'g 6-7.) We agree with Appellants that our reliance on the distinct embodiments in Figures 4 and 11 to affirm the Examiner's anticipation was in error. We nonetheless find this error to be harmless since, as discussed in section 1A above, the thin client in Billington's embodiment in Figure 11 alone possesses sufficient functionality to perform the claimed functions. Therefore, Appellants' arguments are moot since we have maintained the anticipation rejection over a single embodiment.

2. Appellants also argue that the Board erred in finding that Billington's disclosure teaches a server configured to store data to a mass storage device via a stateless client in response to the user's interaction with an application. (Req. Reh'g 7.) In particular, Appellants argue that the

Board's finding is flawed since it misquotes Billington's disclosure by alleging that it allows the client devices to share a plurality of software drivers, when the cited textual portion simply states that the clients can share drives. (*Id*. at 8.)

We agree with Appellants that the original Opinion inadvertently stated that Billington's disclosure teaches that the thin clients can share resources of the processor server including software drivers, as opposed to drives. We find, however, that such oversight merely amounts to a harmless error since we did not rely upon the sharing of drives (or software drivers) to find that the client server can store data in the mass storage device via the thin client. We consequently modify the original Opinion as follows:

As discussed in section 1A above, the interrelationships between the server, the client and the mass storage device stems from the communication and the interaction between these devices. In particular, since Appellants' claim simply requires that the server be *configured to* (or capable of) storing data to the mass storage device via the stateless client, we find that Billington's thin client, by dint of communicating with the processor server and the storage device, is also capable of allowing the server to access the mass storage upon a user's request to do so. Consequently, we maintain our original position that Billington's disclosure reasonably teaches that the thin client possesses sufficient functionality to allow the processor server to store data in the mass storage device in response to a user's requests.

Since Appellants argue claims 1, 8 and 15 as a group, claims 8 and 15 fall with claim 1 for the foregoing reasons.

CONCLUSION

In view of the foregoing discussion, we grant Appellants' Request for Rehearing. We have modified the original Opinion by relying upon the communication between Billington's devices depicted in Figure 11 to infer sufficient functionality for them to be *capable of* or *configured to* perform the functions recited in Appellants' claims 1. While we have modified our analysis in the Opinion, we have maintained our decision to affirm the Examiner's rejections of claims 1 through 21.

This Decision on Request to Rehearing has substantially modified the original Opinion as to become a new Opinion. Pursuant to 37 C.F.R. §§ 41.50(b) and 41.52(a)(1), we treat this new Opinion as containing a new ground of rejection. 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, <u>WITHIN TWO MONTHS FROM THE DATE OF THE DECISION</u>, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

<u>REQUEST FOR REHEARING-GRANTED</u>

nhl

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